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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,104

01/27/2004

Woonza M. Rhee

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04/20/2005

REED INTELLECTUAL PROPERTY LAW GROUP  
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MENLO PARK, CA 94025

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,104

Applicant(s)

RHEE ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Examiner acknowledges receipt of response to election requirement, remarks and preliminary amendment to the specification and claims, all filed 01/19/05. Receipt is also acknowledged for IDS filed 01/27/04. Claims 1-68 are pending.

#### ***Priority***

1. Examiner acknowledges applicants' claim to subject matter disclosed in prior Application No. 10/364,762, filed 02/10/2003 and all the string of related applications and the identification of the examined application as a continuation application of 10/364,762.

#### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered.

#### ***Specification/Drawings***

The brief description of the drawings on page 5, talks about figure 3 showing chemical structures for two commercially available polyethylene glycols containing multiple primary amino acids while the Figure 3 is of two parts, 3a and 3b. Correction of the specification at page 5, paragraph [0028] may be necessary.

### ***Election Requirement***

The response to the election requirement is received. Applicants elected cross-linkable polymer/component having sulfhydryl-reactive groups. However, according to the election practice, the search is extended to cover the other species since the relevant references contain the other species that fall within applicants claimed polymers. Therefore, claims 1-68 are examined.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 16, 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24 and 18-23 of U.S. Patent No. 5,580,923. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 24 of US 5,580,923 is directed to method of formation of adhesion with polymeric material of the type claimed and method of claim 24 is encompassed in the instant method. Issued claim 24 uses the polymer of claims 18-23.

5. Claims 1-25, 29, 33-51, 53-59 and 67 and 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of U.S.

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Patent No. 5,752,974. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method encompasses the issued method and the instant method does not exclude biologically active agents.

6. Claims 1-16 and 35-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 7-13 of U.S. Patent No. 6,166,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method encompasses the issued method and the instant method does not exclude biologically active agent.

7. Claims 1, 19-22 and 35 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,312,725. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method encompasses the method of issued claim 17.

8. Claims 1-22, 29 and 35-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-44, 1, 32-38, 76-81, 48, 49 and 67-72 of U.S. Patent No. 6,495,127. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method encompasses the method of issued claims 41-44, 76 and 79-81. Claim 39-44 uses the composition of claim 1. Claims 76 and 79-81 use the composition of claim 48.

9. Claims 1-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,833,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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instant method encompasses the issued methods and the instant claims do not exclude the presence of biologically active agents.

10. Claims 1-68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/766,095, published as US 2004/0186231 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method encompasses the issued method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 35-68 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating or inhibiting the formation of adhesions following surgery, does not reasonably provide enablement for preventing the formation of adhesions following surgery. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The level of skill in the art is high as it regards the art of inhibiting adhesions and inhibiting adhesion is unpredictable since inhibition is proven for all cases. Thus adequate guidance ought to be provided to practice the invention and the guidance given in the specification does not provide statistical data showing the success of stopping adhesion from

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forming. The standard for prevention is high and applicants' specification has not provided sufficient and adequate guidance to practice the art of preventing. What is the rate of success of administering the polymer to the site following surgery and does that rate meet the high standard of stopping the adhesion from happening? The scope of the enablement provided to the skilled artisan is thus not commensurate with the scope of protection sought. *Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003)

13. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara  
Patent Examiner  
Tech. Center 1600

A handwritten signature in black ink, appearing to read "Blessing Fubara", is written over the printed name.